

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group I, claims 1-5 in the reply filed on October 6, 2008 is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific hydrocarbons, higher alcohols and esters, does not reasonably provide enablement for any solvent with an SP value. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. First, the examiner notes that the solubility parameter value is not a fixed value, but may change depending on with what other solvents the solvent is mixed. The sp value for decane, one of the preferred solvents of the invention, will have a different value in different solvent mixtures. It is conceivable then, that virtually any solvent can be made to have an sp value within the range claimed if it is added to the right combination of additional solvents. This raises the possibility of thousands of solvents that may satisfy this definition, rendering a thorough search of these claims impossible.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As stated above, it is impossible to determine what solvents are being claimed because the sp values for a given solvent change depending on what other solvents are present in a mixture. Even if this were not the case, the sheer number of solvents that satisfy the sp value presently claimed must number in the thousands, such that it is impossible for one of ordinary skill to determine the metes and bounds of the invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Before citing the references against the present claims, the examiner maintains that the present claims are broad to the point where a thorough search is impossible. All that is required in present claim 1 is a solvent and surfactant. There are at least thousands of solvents and thousands of surfactants known in the art, such that there are potentially millions of possible combinations that will satisfy at least present claim 1.

To avoid an onerous action, the examiner has focused on preferred embodiments of the present invention in order to identify the closest prior art. Any response from applicants to the references cited below that does not also address the fact that their claims are extremely broadly written, together with a clear statement of what applicants consider to be the novelty of their invention, will likely not be successful in rendering these claims allowable.

7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Broze, US 5,435,936.

Broze teaches a nonaqueous liquid microemulsion comprising a nonionic surfactant and hexane, hexadecane, and decane (col. 11, example I). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

8. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Moses, US 5,549,836.

Moses teaches a lubricant composition comprising a nonionic surfactant and octadecanol (col. 3, example 1). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

9. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Garrett et al, US 5,597,507.

Garrett et al teach a microemulsion detergent comprising a nonionic surfactant and hexadecane (col. 5, example 1). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

10. Claims 1, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Evers et al, US 5,707,948.

Evers et al teach a hard surface cleaner comprising a nonionic surfactant and hexadecanol (col. 5, example V). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

11. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al, US 6,407,051.

Smith et al teach a microemulsion detergent comprising a nonionic surfactant and hexadecane (col. 11, table 2). Another example comprises a nonionic surfactant and mineral oil (col. 11, table 1). As this reference meets all material limitations of the claims at hand, the reference is anticipatory.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles I. Boyer whose telephone number is 571 272 1311. The examiner can normally be reached on M-Th 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272 1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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